

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1942

No. 369

**MARCONI WIRELESS TELEGRAPH COMPANY OF
AMERICA,**

Petitioner,

vs.

THE UNITED STATES.

**PETITION FOR WRIT OF CERTIORARI TO THE
COURT OF CLAIMS AND SUPPORTING BRIEF.**

✓ ABEL E. BLACKMAR, JR.,

✓ RICHARD A. FORD,

Counsel for Petitioner.

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PETITION FOR WRIT OF CERTIORARI TO THE
COURT OF CLAIMS.

*To the Honorable the Chief Justice and Associate Justices
of the Supreme Court of the United States:*

Your petitioner, Marconi Wireless Telegraph Company of America, respectfully prays for a writ of certiorari, directed to the Court of Claims of the United States, to review the interlocutory and final judgments of that court rendered in this action on November 4, 1935,¹ and April 6, 1942,² respectively. The transcript of record in the case is being filed herewith in accordance with Rule 41 of this Court.³

¹ Findings and opinion reported in 81 C. Cls. 671.

² Not yet reported. The Findings of Fact, Conclusion of Law, and Opinion of the Court will be found at Court R., pp. 117-182.

³ The record, as filed in this Court, includes a portion ("Other parts" R., pp. 2313-2522) which was included at respondent's request. This portion of the record is not material to the issues raised by this petition; it will be material to the case only in the event that respondent files a petition with respect to the Findings of the court below that claim 16 of Marconi patent No. 763,772 was valid and infringed.

Summary Statement of Matter Involved.

Petitioner, at the time of instituting the present action, was the owner, among many other United States Letters Patent, of a reissued patent to Guglielmo Marconi, No. 11,913, the original of which had issued July 13, 1897; a patent to Sir Oliver Lodge, No. 609,154, which issued August 16, 1898; another patent to Marconi, No. 763,772, which issued June 28, 1904; and a patent to Sir John Ambrose Fleming, No. 803,684, which issued November 7, 1905. Each of these patents covered inventions in the then infant field of wireless or radio communication.

This action was brought by petitioner in the Court of Claims of the United States under the Act of Congress of June 25, 1910⁴ (U. S. Code, Title 35, Section 68), to recover compensation for the use, by the respondent, the United States, of apparatus embodying the subject matter of one or more of the four patents above-mentioned. The original petition, filed July 29, 1916, claimed compensation in the sum of \$1,000,000.

On July 1, 1918, the Act of June 25, 1910, was amended to permit the recovery of compensation where the subject matter of a patent had been used *or manufactured by or for* the United States; the amendment also took away the patent owner's right to seek compensation from parties who supplied the Government with infringing apparatus. Thereafter, the patentee's sole remedy was by suit against the United States in the Court of Claims for the recovery of his reasonable and entire compensation. *Richmond Screw Anchor Co. v. United States*, 275 U. S. 331, 343. In view of the changes in the statute and of the greatly increased use of wireless apparatus by the respondent as a result of

⁴ Printed, as amended July 1, 1918, at page 37, *infra*, as Appendix A.

the World War of 1916-1918, petitioner filed, on May 21, 1919, a Supplemental Petition (Court R., pp. 1-6) claiming \$5,000,000 additional compensation. The period covered by the claim extends from July 29, 1910, to the date of expiration of the Marconi reissue and Lodge patents, and, as to the other two patents, to November 20, 1919, the date when petitioner assigned the patents to a third party, the claim against respondent being, however, reserved to petitioner.

The subject matter of the Marconi reissue patent (Plaintiff's Exhibit 15, included in exhibits certified as incorporated by reference in the 1935 findings of the court below; offered "Other parts" R. p. 190), as petitioner considered that it should be construed, was an elevated aerial or antenna for radio communication, one end of which was connected to the earth, or "grounded". The subject matter of the Lodge patent (Plaintiff's Exhibit 20, included in the exhibits incorporated in the findings of the court below; offered "Other parts" R. p. 190) was the insertion in the antenna circuit, of a radio transmitter or receiver or both, of an inductance coil (coil of wire) for the purpose of "tuning" the antenna circuit • • • *i. e.*, making it selectively responsive to a particular, desired wavelength or frequency. The subject matter of the second Marconi patent, No. 763,772 (Plaintiff's Exhibit 21, included in the exhibits incorporated in the findings of the court below; offered "Other parts" R. p. 190-1) was the utilization, at a radio transmitting or receiving station or both, of two circuits (one an "open" or antenna circuit, and the other a "closed" circuit), the two circuits being coupled to each other and both of them being tuned to the same wavelength or frequency. The subject matter of the Fleming patent (Plaintiff's Exhibit 22, included in the exhibits incorporated in the findings of the court below; offered "Other parts" R. p. 191) was a vacuum tube ("valve") for use with

radio, the tube containing a filament ("cathode"), adapted to be heated to incandescence, and another electrode or element ("cold" electrode or "plate"), the filament and plate being connected together by a circuit outside of the tube.⁵

Copies of the Marconi patent No. 763,772 and of the Fleming patent are annexed hereto for the convenience of the Court.

The four patents upon which petitioner's claim was based were the fundamental patents of the radio art and it was upon their disclosures that substantially all of the subsequent marvelous development of that art has been built.⁶

The Marconi reissue patent had been sustained by the District Courts for the Eastern and Southern Districts of New York.⁷ The Court of Claims held that it had not been infringed (Court R. p. 117).

The Lodge patent has been sustained by all courts which have passed upon it, including the court below. The Court of Claims held that it was valid and infringed (Court R. p. 117) and has awarded to petitioner, for respondent's use of the subject matter thereof from March 8, 1913, to August 16, 1915, compensation amounting to \$34,827.70 (plus additional compensation measured by interest) (Court R. p. 135).

The Marconi patent No. 763,772 had been held valid and infringed by the District Court for the Eastern District of

⁵ This is the "Fleming valve" which was several times referred to by this Court in *DeForest Radio Co. v. General Electric Co.*, 283 U. S. 664. See, for example, this Court's references to "Fleming, the inventor of the Fleming valve" and to the Fleming patent above referred to, at page 680 of 283 U. S.

⁶ Respondent's Interdepartmental Radio Board recognized that all four of these patents were fundamental (see brief, p. 12 *infra*).

⁷ *Marconi Wireless Telegraph Co. of America v. National Electric Signaling Co.*, 213 Fed. 815; *Same v. DeForest Co.*, 138 Fed. 657.

New York; * it had also been held valid, but not infringed, by the District Court for the District of Washington in a decision which was affirmed by the Circuit Court of Appeals for the Ninth Circuit.⁹ Both of these decisions were rendered after strenuously contested trials, most of the testimony, in the latter case at least, having been taken in open court. The corresponding British Marconi patent had been twice sustained by the High Court of Justice, Chancery Division;¹⁰ and the corresponding French patent had been sustained by the Civil Tribunal of the Seine.¹¹ The Court of Claims, however, on testimony taken before an Examiner, held that all claims in issue of the patent were invalid, except claim 16 (a very limited claim) which was held valid and infringed (Court R. p. 117).¹²

The Fleming patent had been held valid and infringed, after a strenuously contested trial in open court, by the District Court for the Southern District of New York, in a decision which was affirmed by the Circuit Court of Appeals for the Second Circuit.¹³ The District Court also held, on a

* *Marconi Wireless Telegraph Co. of America v. National Electric Signalling Co.*, 213 Fed. 815. No appeal was taken, the defendant taking a license (Plaintiff's Exhibit 360, included in exhibits incorporated in the findings of the court below; offered "other parts" R., p. 2101 c).

⁹ *Marconi Wireless Telegraph Co. of America v. Kalbourn & Clark Mfg. Co.*, 265 Fed. 644, affirming 239 Fed. 328; decree, Plt's Exh. 364 (~~"other parts"~~ R., pp. 2500-3, offered "Other parts" R., p. 2103 a).

¹⁰ *Marconi v. British Radio Tel. & Tel. Co.*, (1911) 27 T. L. R. 274; 28 R. P. C. 181; the Judgment is Plaintiff's Exhibit 7 (~~"other parts"~~ R., pp. 1600-1640; offered "Other parts" R., p. 186). *Marconi v. Helshu Wireless Telegraph Co.*, (1914) 30 T. L. R. 688; 31 R. P. C. 399; the Judgment is Plaintiff's Exhibit 35 (~~"other parts"~~ R., pp. 1642-7; offered "Other parts" R., p. 202).

¹¹ *Societe Marconi v. Societe Generale, etc.*, Plt's Exh. 36 (~~"other parts"~~ R., pp. 1648-1708; offered "Other parts" R., p. 202).

¹² Commissioner Johns, who reported on the issues of validity and infringement of petitioner's patents, had heard none of the testimony.

¹³ *Marconi Wireless Telegraph Co. of America v. DeForest Radio Tel. & Tel. Co.*, 243 Fed. 560 affirming 236 Fed. 942.

contested motion to extend the decree, that certain additional apparatus infringed the Fleming patent (Pltf's Exh. 171; "~~Other parts~~" R. pp. 2104-5; offered "Other parts" R. p. 1346); and, after a trial in open court on Supplemental Bill, that still other apparatus also infringed the patent (261 Fed. 393). The Court of Claims, on testimony taken before an Examiner,¹⁴ held that the patent had not been infringed, and indicated, in its opinion, that it considered the patent invalid (although not actually holding it invalid). (Court R. pp. 117, 105).

Although the patents have expired, the petitioner corporation has been kept alive for the purpose of prosecuting the present action in order to secure for its former stockholders a recovery for respondent's use of these important patents,—the claim against respondent being petitioner's sole remaining asset. (See Special Findings of Fact of the court below of November 4, 1935, Nos. VI and VII, together with the documents incorporated therein by reference; Court R. pp. 9-11.)

The present petition seeks a review of the decision of the Court of Claims only with respect to the Marconi patent No. 763,772 and the Fleming patent No. 803,684. As the Marconi reissue patent expired July 13, 1914, and as respondent's use of wireless apparatus up to that date was relatively small, no review is sought of the decision of the court below with respect to that patent.

As a result of the decision of the Court of Claims, petitioner, the owner of the four fundamental patents in the radio art (all previously sustained by courts of the United States), has been awarded less than \$80,000 (plus additional compensation measured by interest) for respondent's purchase or manufacture and use, during the period covered by the claim, of upwards of \$40,000,000 worth of radio

¹⁴ See footnote 12, above.

apparatus.¹⁵ We respectfully submit that this constitutes a substantial failure of justice for reasons set forth in our supporting brief (see p. 26, *infra*).

II.

The Questions Presented.

The questions presented are as to the validity and infringement of claims 1, 2, 3, 6, 8, 10 to 14, and 17 to 20 of the Marconi patent No. 763,772 and of claims 1 and 37 of the Fleming patent No. 803,684.

III.

Reasons Relied On for the Allowance of the Writ of (Certiorari.

(1) Because the Court of Claims, in finding that the Marconi patent No. 763,772 was invalid as to claims 1, 2, 3, 6, 8, 10 to 14, and 17 to 20, and in failing to find that these claims were infringed by the apparatus described in its Special Findings of Fact XLVI, XLVIII, XLIX, and L of November 4, 1935, rendered a decision in conflict with the decisions of the Circuit Court of Appeals for the Ninth Circuit and the United States District Courts for the District of Washington and for the Eastern District of New York, on the same question and on substantially the same evidence, in *Marconi Wireless Telegraph Company of America v. Kilbourne & Clark Manufacturing Co.* (265 Fed. 644, affirming the decision of the Washington District Court, 239 Fed. 328), and in *Marconi Wireless*

¹⁵ *Other parts* R., p. 1957. The Interdepartmental Radio Board recommended to Congress that petitioner be awarded over \$1,250,000 as compensation for respondent's use of the subject matter of the Lodge patent, the Marconi patent No. 763,772, and the Fleming patent (see brief, p. 20, *infra*).

Telegraph Company of America v. National Electric Signalling Co. (213 Fed. 815), respectively.¹⁶

(2) Because the Court of Claims, in finding that claims 1 and 37 of the Fleming patent No. 803,684 were not infringed and in failing to find that these claims were valid, rendered a decision in conflict with the decisions of the Circuit Court of Appeals for the Second Circuit and the United States District Court for the Southern District of New York, on the same question and on substantially the same evidence, in *Marconi Wireless Telegraph Company of America v. DeForest Radio Telephone & Telegraph Co.*¹⁷ (243 Fed. 360, affirming the decision of the District Court, 236 Fed. 942); *Same v. Same* (memorandum opinion of the District Court; ^{Exhibit} ~~"Other parts"~~ R., pp. 2104-5); and *Same v. Same* (261 Fed. 393, S. D., N. Y.).

(3) Because the Court of Claims, in limiting petitioner's compensation, for the use by respondent of upwards of \$40,000,000 worth of radio apparatus during the accounting period, to less than \$80,000 (plus additional compensation measured by interest), has rendered a decision which, in view of the prior recognized fundamental position of petitioner's patents in the radio art and in view of the proposed award to petitioner by the Interdepartmental Radio Board of upwards of \$1,250,000, has resulted in a failure of justice as between the United States and one of its citizens.

¹⁶ *The National Electric Signalling Co.* decision was followed by the District Court for the Southern District of New York, on a contested preliminary injunction motion, in *Marconi Wireless Telegraph Company of America v. DeForest, etc., Co.*, 225 Fed. 65; this decision was affirmed by the Circuit Court of Appeals for the Second Circuit, 225 Fed. 373. (See also Plaintiff's Exhibit 345, ~~"Other parts"~~ ^{Exhibit} R., pp. 2473-7; offered "Other parts" R., p. 2094).

¹⁷ This decision was followed by the District Court for the District of Delaware, on a contested motion for a preliminary injunction, in *Marconi Wireless Telegraph Company of America v. Radio Audion Co.*, 278 Fed. 628.

WHEREFORE, your petitioner respectfully prays that a Writ of Certiorari be issued out of and under the seal of this Honorable Court, directed to the Court of Claims of the United States, commanding that court to certify and send to this Court on a day to be designated, a full and complete transcript of the record and all proceedings in this cause, in so far as the same are material to the errors herein assigned, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Court of Claims of the United States be reversed in so far as errors therein have been assigned by your petitioner; and that petitioner be granted such other and further relief as may seem proper.

Dated, August 31, 1942.

ABEL E. BLACKMAR, JR.,

RICHARD A. FORD,

Counsel for Petitioner.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Court Below.

The 1935 opinion of the Court of Claims of the United States on the issues of validity and infringement of the patents in suit is reported at 81 Ct. Cls. 741.

The 1942 opinion of the said court on the accounting proceeding is not yet reported, but will be found in the printed record at page 157.

Jurisdiction.

1. The final judgment of the Court of Claims, now sought to be reviewed, was rendered April 6, 1942 (Court R., p. 182).

2. By an order of the Chief Justice of this Court, dated May 21, 1942, petitioner's time to file its petition for writ of certiorari was extended to September 4, 1942.

3. The judgment was rendered in an action to recover compensation for the use or manufacture by or for the respondent, the United States, of apparatus embodying the subject matter of four letters patent of the United States; the action was brought under the Act of June 25, 1910, as amended July 1, 1918 (U. S. Code, Title 35, Section 68).

4. The jurisdiction of this Court is invoked under Sections 3 and 8 of the Act of February 13, 1925, as amended by the Act of May 22, 1939 (U. S. Code, Title 28, Sections 288 and 350).

5. Some of the cases believed to sustain the jurisdiction are:

Wilson & Co. v. United States, 311 U. S. 104;

United States v. Pelzer, 312 U. S. 399;

American Chicle Co. v. United States, — U. S. —, 86 L. Ed. 1106;

Standard Refrigerator Co. v. Winters, 280 U. S. 30;

Toledo Pressed Steel Co. v. Standard Parts, 307 U. S. 350;

Honolulu Oil Co. v. Halliburton, 306 U. S. 550.

Statement of the Case.

The facts, so far as this application is concerned, are stated in the petition. We wish, however, to add the following:

Both Senatore Guglielmo Marconi and Sir Ambrose Fleming, patentees of the two patents involved in this application, were widely recognized in the radio art as having made contributions of great value to the development thereof. Their patents which were involved before the Court of Claims in the present suit cover these contributions.

The two Marconi patents covered the fundamental features which made it possible for him to be the first to transmit intelligible messages across the Atlantic Ocean and which resulted in his becoming known as the "father of wireless". His position in the art of wireless telegraphy was recognized by Congress, when, on April 13, 1908,¹⁸ it authorized and directed the Secretary of the Interior to grant permission to the Marconi Memorial Foundation, Inc., for the erection on public grounds of the United States in the District of Columbia, of a memorial "to the late Guglielmo Marconi, inventor of an apparatus for

¹⁸ This was after the Court of Claims had held the Marconi reissue patent not infringed and all the broad claims of the second Marconi patent invalid.

wireless telegraphy", by the American people (Public Resolution No. 86, 75th Congress).¹⁹

Fleming likewise initiated, by the disclosure of the invention of his patent here in suit, a tremendous advance in the wireless art. His two-element tube or "valve" was the foundation upon which DeForest built his three-element tube or "audion" which opened up a multitude of new and unsuspected possibilities and which, in various improved forms, is in practically universal use to day.

These facts have been judicially recognized not only in this country, but, as to the subject matter of Marconi patent No. 763,772, in England and France (see the cases referred to at page 5 of the Petition).

The fundamental character of petitioner's patents here in suit was also recognized by respondent's Interdepartmental Radio Board (the functions of which are described at pages 19-29, *infra*). The representative, on that Board, of the Department of Justice, said, before a Congressional committee, that "Those four patents are all fundamental."²⁰

In considering these patents, it should be borne in mind that, as they expired considerably more than six years ago, no further claim for infringement of either of them can hereafter be made by petitioner or its assignee, either against respondent or anyone else.

Specification of Errors.

The errors which petitioner will urge, if the writ of certiorari is granted, are that the Court of Claims of the United States erred:

1. In holding that claims 1, 2, 3, 6, 8, 10 to 14, and 17 to 20 of Marconi patent No. 763,772 were invalid;

¹⁹ A copy of this Resolution is appended hereto at page 37, *infra*, as Appendix B.

²⁰ Phil's Ex. 122, *Exhibit* R, Vol. III, p. 1972.

2. In holding that the subject matter of said claims lacked invention;

3. In holding that the subject matter of said claims, or certain of them, was anticipated in the prior art;

4. In failing to hold that said claims of Marconi patent No. 763,772 involved invention, that they covered new and useful subject matter, and that Marconi was the first inventor of the subject matter thereof;

5. In failing to hold that said claims were valid;

6. In failing to make the ultimate finding of fact that said claims of Marconi patent No. 763,772 were infringed by the apparatus described in the Special Findings of Fact of the Court of Claims, Nos. XLVI, XLVIII, XLIX, and L, of November 4, 1935 (81 C. Cls. 705-710);

7. In failing to enter a judgment awarding to petitioner compensation for the manufacture and use by and for the respondent of apparatus utilizing the subject matter of claims 1, 2, 3, 6, 8, 10 to 14, and 17 to 20 of Marconi patent No. 763,772;

8. In failing to hold that claims 1 and 37 of Fleming patent No. 803,684 involved invention, that they covered new and useful subject matter, and that Fleming was the first inventor of the subject matter thereof;

9. In failing to hold that said claims of the Fleming patent were valid;

10. In holding that said claims of Fleming patent No. 803,684 were not infringed by the apparatus described in the Special Findings of Fact of the Court of Claims, Nos. LXXV, LXXVI, LXXVIII, and LXXIX, of November 4, 1935 (81 C. Cls. 735-740);

11. In failing to hold that said claims of the Fleming patent were infringed by the apparatus described in said find-

ings Nos. LXXV, LXXVI, and LXXIX, and that claim 1 of said patent was infringed by the apparatus described in said finding No. LXXVIII:

12. In failing to enter a judgment awarding to petitioner compensation for the manufacture and use by and for the respondent of apparatus utilizing the subject matter of claims 1 and 37 of Fleming patent No. 803,684.)

Summary of Argument.

The various points or propositions which are set forth under the following captions summarize the argument.

ARGUMENT.

POINT I.

The Court of Claims, in holding that claims 1, 2, 3, 6, 8, 10 to 14, and 17 to 20 of Marconi patent No. 763,772 were invalid, has rendered a decision in conflict with the decisions of the Circuit Court of Appeals for the Ninth Circuit and the United States District Courts for the District of Washington and for the Eastern District of New York, on the same question and on substantially the same evidence, in Marconi Wireless Telegraph Company of America v. Kilbourne & Clark Manufacturing Co., (265 Fed. 644, affirming the decision of the Washington District Court, 239 Fed. 128), and in Marconi Wireless Telegraph Company of America v. National Electric Signalling Co., (213 Fed. 815), respectively.

Prior to the decision of the Court of Claims, the Marconi patent No. 763,772 and the corresponding British and French patents had been sustained as valid by all courts to which that question had been presented.

The first decision, in point of time, was that of Mr. Justice Parker of the High Court of Justice, Chancery Di-

vision. Its judgment was delivered February 21, 1911.²¹ Justice Parker held that Marconi's British patent No. 7,777 of 1900 (plaintiff's exhibit 34, included in exhibits certified as incorporated by reference in the court's findings; offered "Other parts" R. p. 202), corresponding to his patent here in suit No. 763,772, was valid and infringed, the invention covered thereby "producing an entirely new and useful result" (~~"Other parts"~~ R. Vol. III, p. 1631).

In December, 1912, the Civil Tribunal of the Seine held that Marconi's corresponding French patent (No. 305,060; plaintiff's exhibit 142, ~~"Other parts"~~ R. Vol. IV, p. 2009; offered "Other parts" R. p. 532) was valid and infringed.²² That court called the invention "a wonderful conquest" and said that "the Marconi patent stands out as an unassailable monument until new discoveries are made" (~~"Other parts"~~ R. Vol. III, pp. 1663, 1690; see also ~~"Other parts"~~ *Exhibit* R. Vol. III, pp. 1705-6).

The first decision in this country on Marconi patent No. 763,772, here in suit, was that of Judge Veeder in the *National Electric Signalling Co.* suit above referred to (213 Fed. 845). In that case, decided in 1914, the patent was held valid and infringed, Judge Veeder stating (213 Fed. 848) that Marconi had overcome the difficulties existent in prior art arrangements, and that:

"In combination with the increased available energy in the transmitter, the distance over which messages could be sent was enormously increased. With this apparatus Marconi communicated across the Atlantic in 1901, and the claims in issue constitute the essential

²¹ The judgment in this case, *Marconi v. British Radio Tel. Co.*, is reported in (1911) 27 T. L. R. 274, 28 R. P. C. 181; a copy is in evidence as plaintiff's exhibit 7 (~~"Other parts"~~ R. Vol. III, pp. 1600-1640; offered "Other parts" R., p. 186). *Exhibit*

²² A translation of the judgment in this case, *Societe Marconi v. Societe Generale, etc.*, is in evidence as plaintiff's exhibit 36, ~~"Other parts"~~ R. Vol. III, pp. 1648-1708; offered "Other parts" R., p. 202. *Exhibit*

features of apparatus which has since made possible communication over a distance of 6,000 miles. It is used in more than 1,000 installations by Marconi, and is admittedly an essential feature of the wireless art as at present known and practiced."

Judge Veeder also referred to the subject matter of this Marconi patent as a "conspicuous advance in wireless telegraphy". (213 Fed. 858.)

Judge Veeder's decision was followed, on motion for preliminary injunction, **by the District Court for the Southern District of New York in *Marconi Wireless Telegraph Co. of America v. DeForest, etc., Co.*** 225 Fed. 65. This decision was affirmed by the Circuit Court of Appeals for the Second Circuit (225 Fed. 373).

In July, 1914, the High Court of Justice, Chancery Division (Mr. Justice Eve), again held that Marconi's British patent No. 7,777 of 1900 was valid and infringed.²³

In December, 1916, Marconi's American patent was again held valid, this time by the District Court for the District of Washington in the *Kilbourne & Clark Mfg. Co.* case above referred to (239 Fed. 328). Although the court there held that the patent had not been infringed, yet the decree (dated July 16, 1917) specifically held that Marconi patent No. 763,772 is "good and valid in law as to claims 1, 2, 3, 6, 8, 10, 11, 12, 13, 14, 16, 17, 18, 19, and 20" and that "Marconi was the first, true, original and sole inventor of the inventions described in said Letters Patent and claimed in the said claims" (plaintiff's Exhibit 364, ~~"Other parts"~~ ^{Exhibit} R., Vol. IV, pp. 2501-2; offered "Other parts" R., p. 2103). This District Court stated that what Marconi did "was a real accomplishment" and that the ideas involved in the

²³ The judgment in this case, *Marconi v. Helsby Wireless Telegraph Co.*, is reported in (1914) 30 T. L. R. 633, 31 R. P. C. 399; a copy is in evidence as plaintiff's exhibit 35 (~~"Other parts"~~ ^{Exhibit} R., Vol. III, pp. 1642-7, offered "Other parts" R., p. 202).

patent "have proven of great value to the world." (239 Fed. 335, 342.)

The defendant, in the *Kilbourne & Clark* case, took a cross appeal from the adjudication of validity of the Marconi patent; on this appeal, the Circuit Court of Appeals for the Ninth Circuit considered the question of validity (see 265 Fed. 644, 661) and affirmed the decree of the District Court upholding the patent. In this respect, the Court of Claims was in error in stating (81 C. Cls. 762) that the validity of the Marconi patent was not passed upon in the *Kilbourne & Clark* case.²⁴

In the face of this formidable array of decisions holding the Marconi patent valid, the Court of Claims, although stating in its 1935 Special Finding XLIV herein (81 C. Cls. 765) that

"The invention of patent \approx 763772 went into wide use in the United States and elsewhere. Apparatus embodying the invention of \approx 763772 was employed in the first transatlantic radio signalling",

nevertheless held the patent invalid.

All of the prior art relied upon by the respondent in the present case with respect to this Marconi patent was admittedly involved in one or another of the prior American suits based on that patent (respondent's expert Loftin, "Other parts" R., p. 1068). For example, Marconi's prior patent No. 627,650 was discussed by Judge Veeder in the *National Electric Signalling* case, 213 Fed. 815, 859-860; the corresponding British patent was also discussed by Mr. Justice Parker ("~~Other Parts~~" R., Vol. III, p. 1609). The Tesla patent No. 645,576 was also discussed by Judge Veeder (213 Fed. 855-7) as well as by the French court ("~~Other Parts~~" *Exhibit*

²⁴ Even though the Marconi patent was held not infringed in the *Kilbourne & Clark* case, the adjudication of validity "stands as an adjudication of one of the issues litigated." *Electrical Fittings Corp. v. The Thomas & Betts Co.*, 307 U. S. 241.

R., Vol. III, pp. 1685-1690). And the alleged 1899 correspondence between Stone and Baker was in evidence in the *Kilbourne & Clark* case and quoted, in part, in the opinion of the District Court (239 Fed. 339).

The prior American decisions were rendered after strenuously contested trials in which some or all of the testimony was taken in open court. In the Court of Claims, on the other hand, all of the testimony on the issues of validity and infringement was taken before an Examiner, usually a Notary Public; even the Commissioner who made the report on validity and infringement had heard none of the testimony.

Of course, the accomplishment of a patentee is measured by the advance made by him over the sum of human knowledge available at the time he made his invention. It is therefore important to appreciate that the decisions in all of the prior cases were rendered at a much earlier stage of the radio art, *i. e.* at a time when the point of view of the witnesses, especially of the experts, more nearly reflected the point of view existent at the time the invention was made. The decision of the Court of Claims was rendered some thirty-five years after Marconi made the invention covered by his patent No. 763,772, after the phenomenal development of the art that started about 1916 as a result of the incentive of the World War of 1914-1918, and after years of advanced and intensive study and research which naturally made the original advances in the art seem, by comparison, simple and obvious. In other words, by 1935, when the first decision below was rendered, it had become extremely difficult, if not impossible, to recapture the point of view of 1900, whereas, in 1911-1916, when the prior decisions were rendered, comparatively little advance had been made in the art and the work of Marconi and other early inventors could be more easily seen in its true perspective. That which was made to the court below to appear, in 1935, to

have been obvious in 1900, did not appear to at least four courts, in 1911-1916, to have been obvious. Petitioner submits that this fact alone should lead this Court to scrutinize the decision of the Court of Claims in a review of this case.

In addition to the prior decisions mentioned above, consideration should also be given to the following facts:

In 1919, after the termination of the first World War, the Attorney General, the Secretary of the Navy, and the Secretary of War organized the Interdepartmental Radio Board, a group of representatives of these three departments. The function of the Board was to consider the claims of owners of various patents for inventions in the radio field for compensation for the use of the inventions by the United States during the war period, and to recommend the amount of compensation, if any, to which the claimants were entitled. ("Other parts" R., pp. 1099 *et seq.*)

The Board included a patent attorney of long experience in litigation involving radio patents, and a Naval officer (Lieutenant Commander Loftin, Chairman of the Board) who subsequently acted as the chief technical expert for respondent in the present case. The Board undertook "a very careful consideration of the whole situation"; it familiarized itself not only with the many patents on which claims were based but with the great mass of applicable prior patents and publications, possible prior uses where known, prior litigation involving the patents, and the structure and operation of such of respondent's apparatus as was asserted to infringe. Informal hearings were held. The Board determined whether and to what extent, in its opinion, the patents were valid and infringed,—seeking to arrive at the conclusion that would be arrived at by the Courts of Claims. ("Other parts" R., pp. 1099 *et seq.*) The work of the Board extended over a period of nearly two years and a half ("Other parts" R., p. 1104).

In 1921, the Board recommended to the heads of the three Departments that petitioner be awarded compensation in the sum of over \$1,250,000 for respondent's use of the Lodge patent, the Marconi patent No. 763,772, and the Fleming patent. This recommendation was accepted by the heads of the Departments, as well as by the petitioner.

The recommendations were thereafter presented to the Committee on Military Affairs of the House of Representatives. At the Committee hearings, the Board was represented primarily by Commander Loftin who urged that Congress accept the recommendations and appropriate the funds to pay the various claimants (Plaintiff's Exhibit 122, "~~Other parts~~" R., pp. 1934 *et seq.*; offered "~~Other parts~~" R., p. 1098). The Committee on Military Affairs reported the proposed bill favorably to the House of Representatives (Plaintiff's Exhibit 363, "~~Other parts~~" R., Vol. IV, pp. 2496 *et seq.*; offered "~~Other parts~~" R., p. 2103), but Congress failed to pass the necessary legislation.

Thus there are arrayed against the 1935 decision of the court below to the effect that the above-mentioned claims of Marconi patent No. 763,772 were invalid the following decisions:

1. The 1914 decision of Judge Veeder in the Eastern District of New York (and the decisions of the southern New York District Court and the Second Circuit Court of Appeals which followed Judge Veeder's decision);
2. The 1920 decision of the Circuit Court of Appeals for the Ninth Circuit affirming the 1916 decision of the District Court for the District of Washington;
3. Two decisions, rendered in 1911 and 1914, of the High Court of Justice, Chancery Division, in England;
4. The 1912 decision of the Civil Tribunal of the Seine, in France; and

5. The recommendation, in 1921, of respondent's Inter-departmental Radio Board.

Petitioner respectfully submits that, under the circumstances above set forth, this Court should grant petitioner's writ of certiorari and review the decision of the Court of Claims as to the validity of claims 1, 2, 3, 6, 8, 10 to 14, and 17 to 20 of Marconi patent No. 763,772.

On the issue of infringement of said claims of this second Marconi patent in suit, it is clear from the 1935 Special Findings of Fact of the Court of Claims, Nos. XLVI, XLVIII, XLIX, and L, and from the opinion of that Court that that court considered that, if the claims were valid, they were infringed by respondent's apparatus described in those Findings. Therefore, no review of such Findings is requested by petitioner; the only thing that is sought on this issue is the ultimate Finding that said claims of Marconi patent No. 763,772 were infringed by such apparatus.

POINT II.

The Court of Claims, in holding that claims 1 and 37 of Fleming patent No. 803,684 were not infringed, and in failing to hold that these claims were valid, has rendered a decision in conflict with the decision, rendered on the same questions and on substantially the same evidence, of the Circuit Court of Appeals for the Second Circuit, in Marconi Wireless Telegraph Company of America v. DeForest Radio Telephone & Telegraph Co. (243 Fed. 560, affirming 236 Fed. 942), and the two subsequent decisions of the United States District Court for the Southern District of New York in the same case (memorandum opinion of July 11, 1917, not reported,²⁵ and 261 Fed. 393).

²⁵ This memorandum opinion appears at "Other parts" R., Vol. IV, pp. 2104-5.

The trial of the case against DeForest Radio Telephone & Telegraph Co. was a strenuously contested trial, substantially all of the evidence having been taken in open court. The questions involved were identical with those in the present case, namely, whether claims 1 and 37 of the Fleming patent were valid and whether they were infringed by the use of three element vacuum tubes (then usually referred to as "audions") in wireless or radio detection (the use described in the 1935 Special Findings of Fact of the Court of Claims herein, Nos. LXXV and LXXIX; 81 C. Cls. 735, 740). The District Court (the late Judge Mayer) held that the patent was valid and infringed; the decision was affirmed on appeal, Judge Hough writing the opinion.²⁶

On a motion to extend the injunction in the *De Forest* case to cover the use of three element tubes in amplifiers and in generators of oscillations ("oscillators" or "Oscillations"), the District Court held, in a memorandum opinion (~~100 Fed. Cl. R.~~ ^{100 Fed. Cl. R.} pp. 2104-5), that amplifiers, being part of a detector, were within the prior decree but that, as to oscillators, further evidence should be presented.

Accordingly, there was a further trial in open court after which the District Court held that the use of three element tubes in generators of oscillations infringed claim 1 of the Fleming patent.²⁷

The Fleming patent was also before the Interdepartmental Radio Board, which recommended that petitioner receive compensation for respondent's use of three electrode tubes in detectors, amplifiers, and oscillators.

In direct conflict with these decisions, the Court of Claims held, on evidence taken before an Examiner, that none of

²⁶ This decision was followed, on a contested motion for preliminary injunction, by the District Court for the District of Delaware, in *Marconi Wireless Telegraph Co. of America v. Radio Audion Co.*, 278 Fed. 628.

²⁷ No appeals were taken by the defendant from the decisions that the patent was infringed by amplifiers and oscillators.

the apparatus used by respondent infringed either claim 1 or claim 37 of the Fleming patent.

As in the case of the Marconi patent, all of the prior art here relied upon by respondent with respect to the Fleming patent was admittedly involved in the prior (DeForest) litigation (Loftin, "Other parts" R., p. 1068).

As to the decisions of the courts in the *DeForest* case, the Court of Claims said, first, "that both sides represented to the Court and agreed that the inherent qualities of the two-electrode tube and the three-electrode tube are the same." (81 C. Cls. 781); and, second, that those decisions were "quite incorrect" (81 C. Cls. 784).

As to the former statement, the Court of Claims was, we submit, in error.²⁸

Contrary to the inference that might be drawn from this statement in the opinion of the Court of Claims, the *DeForest* case was a bitterly contested one.

The plaintiff in that case (petitioner here) did, of course, take the position that the two-electrode tube or Fleming valve was inherently capable of performing the same functions as the three-electrode tube or audion—just as it has done in this case. But the defendant in the *DeForest* case,

²⁸The statement in Judge Mayer's opinion (246 Fed. 953) that "both sides agree that the *DeForest* two-element and three-element bulbs operate on the same principle", and that of the Circuit Court of Appeals (243 Fed. 565) that "it is agreed that the 'two' and 'three' electrode *audions* operate on the same basic principle" apparently misled the Court of Claims. What was meant by these statements is clarified by the Court of Appeals at 243 Fed. 562, where it is pointed out that the defendant in that case insisted that the [Fleming] valve and the Audion utilize and depend for efficiency upon wholly different operations of nature". It was only in connection with certain *DeForest* patents (subject matter of a counterclaim and held either invalid or not infringed) as to which defendant contended that the principle of operation was the same; it was the devices of these patents that the courts in the *DeForest* case referred to in speaking of "DeForest two element" bulbs and "two-electrode audions"—not the device of the Fleming patent.

(Emphasis in this brief, is ours unless otherwise stated.)

like the respondent here, took the definite position that the audion operated on entirely different principles from the Fleming valve. To support this statement of ours and to show that the court below misunderstood the position of the defendant in the *DeForest* case, we here quote from briefs of that defendant. In the main brief before the District Court, counsel for the DeForest Company said:

"The attempt to make out infringement [of the Fleming patent] by saying that the Audion has the Fleming circuit 'split up' is too vague a generalization in view of *the different operation of the two devices resulting from the existence of two instead of one circuit.*"

"* * * a patentee cannot expand his patent to cover changes which cause the device to *function in an entirely different manner.*" * * * (P. 339).

"The attempt now being made to sweep within the monopoly of the Fleming patent the PN Audion with its *radically different mode of operation*, is similar", etc. (P. 341.)

In the main brief for the DeForest Company before the Circuit Court of Appeals appears (at page 62) a heading reading as follows:

"The Audion and its Mode of Operation are *Vitalily Different in all Essential Features* from the Fleming Device and Fleming's Mode of Operation."

It is then stated that

"The audion is *radically different* from the device of the Fleming patent *in principle, in essentials of apparatus and circuit connections, in purpose, and in the uses to which it is put.*"

There follows a section of over twenty five pages devoted to an effort to show so-called "*Contrasting Laus of Operation* of Fleming and of the Audion" (pp. 63-90). And the Circuit Court of Appeals said (243 Fed. 562) that defendant

(the DeForest Company) insisted "that the [Fleming] valve and the audion utilize and depend for efficacy upon *wholly different operations of nature.*"

In fact the DeForest Company, in its briefs in that case, made substantially every argument of non-infringement that the respondent has made herein.

We respectfully submit that the Court of Claims, in stating that the decision in the *DeForest* case "has no application to the instant case" (81 C. Cls. 781) was clearly in error.

The statement of the Court of Claims that the decision of the Court of Appeals in the prior case was "quite incorrect" merely emphasizes the conflict between the two decisions and shows that the present case falls directly within the category of cases in which this Court normally grants a writ of certiorari.

The Court of Claims made no finding herein as to the validity of the Fleming patent. In its opinion, however, it indicated (81 C. Cls. 774) that it considered the Fleming patent to be invalid because of unreasonable delay in making the disclaimer. In this respect, again, the Court of Claims was in conflict with the decisions in the *DeForest* case. The Court of Appeals held in that case (243 Fed. 565) that the disclaimer was proper and did not affect the validity of the patent.²⁹

Petitioner respectfully submits that, in view of the direct conflict of decision between the Court of Claims and the Circuit Court of Appeals for the Second Circuit with respect to the Fleming patent, this Court should review the

²⁹It cannot be said that this decision was reached without proper presentation of the question on behalf of the DeForest Company, for, in a Supplemental Memorandum, presented by the late Frederick P. Fish (probably the leading patent attorney of the Bar at that time), several pages were devoted to the argument that the "Fleming Patent is Void Because . . . there was Unreasonable Neglect and Delay in Filing the Disclaimer." (Pp. 1 to 11 of said supplemental Memorandum.)

judgment herein holding that petitioner is not entitled to compensation with respect to that patent.

POINT III.

The Court of Claims, in limiting petitioner's compensation, for the use by respondent of upwards of \$40,000,000 worth of radio apparatus during the accounting period, to less than \$80,000 (plus additional compensation measured by interest), has rendered a decision which, in view of the prior recognized fundamental position of petitioner's patents in the radio art and in view of the proposed award to petitioner by the Interdepartmental Radio Board at upwards of \$1,250,000, has resulted in a failure of justice as between the United States and one of its citizens.

We have set forth above the function of and procedure followed by the Interdepartmental Radio Board, the fact that it described petitioner's patents involved in this case as the fundamental patents in the radio art, and its recommendation that Congress appropriate over \$1,250,000 as compensation to petitioner. Although the action of the Board was without prejudice and is therefore not binding on respondent, yet we submit that it should be considered here in view of the character and purpose of the Board. Its recommendation with respect to petitioner's claim shows what the Departments of Justice, Navy, and War considered, after over two years' study of the radio patent situation, that petitioner was entitled to receive from respondent.

We respectfully submit that the judgment of the Court of Claims, awarding to petitioner a sum only about 6½% of the sum recommended by the Interdepartmental Radio Board, should challenge the attention of this Court and that this Court should not permit the judgment to stand without a review of the findings upon which it was based.

POINT IV.

The Marconi patent No. 763,772 was valid as to claims 1, 2, 3, 6, 8, 10 to 11, and 17 to 20 thereof, and the subject matter of said claims was used by respondent.

A. Said claims of the patent were valid.

The substance of the invention of Marconi patent No. 763,772 is very simply and briefly stated in the Petition (*supra*, pp. 3-4).

The general principles of wireless that are essential for an understanding of the invention of this patent and of what preceded it; the history of the art up to the time Marconi made the invention covered by this patent; and the nature of the invention, as well as what was accomplished thereby (both scientifically and practically), are set forth in considerable detail in the opinions of Judge Veeder and of Mr. Justice Parker, above referred to.

It does not appear to us to be necessary, at this stage of the case, to add to these statements nor to argue at length the merits of the case. Also, in petitioner's opinion, the discussion in the two above decisions and that of the French court of the prior art and of the question of presence of invention is a sufficient treatment thereof for present purposes. The only evidence bearing on the validity of the Marconi patent that can be found in the Special Findings of the court below which was not discussed in these prior decisions is the so-called "Stone defense".

Stone is alleged to have written two letters (of doubtful authenticity as to dates) to Baker prior to Marconi's application date (defendant's Exhibits F-3 and G-3; included in the exhibits that were incorporated in the court's 1935 Findings; offered "Other parts" R., p. 733); excerpts from the letters are quoted in the opinion of the District Court

in the *K. J. Bourne v. Clark* case (which held the Marconi patent to be valid)³⁰ and in the Findings of the court below. There was also in evidence a patent to Stone, No. 714,756 (defendant's Exhibit X-3; included in the exhibits incorporated in the court's 1935 Findings; offered "Other parts" R., p. 866) the application for which was filed prior to the Marconi application but which did not issue as a patent until after the Marconi application had been filed.

Petitioner submits that the Stone-Baker letters, even if authentic (which is doubtful) do not disclose the Marconi invention; that, even if they do, they do not, under existing law, invalidate the Marconi patent; and that the Stone patent application, as it existed at any time prior to Marconi's date, did not disclose the Marconi invention.³¹

The court below did not hold the Marconi patent invalid on the basis of the Stone-Baker letters, saying (81 C. Cls. 767-8): "It is not necessary that we should decide whether a private letter such as Stone wrote to his friend would constitute a disclosure which would affect the Marconi patent. . . ."

Judging from the 1935 opinion of the Court of Claims, the Marconi patent was held invalid for want of invention

³⁰ The court below evidently overlooked this fact for it stated in its opinion (81 C. Cls. 767) that

"It was unnecessary for him [Judge Neterer] to pass on the validity of the Marconi tuning patent and he did not do so. . . . If any inference is to be drawn from his opinion it is that it was proper to take into consideration the Stone letters."

However, Judge Neterer signed a decree upholding the validity of the Marconi patent (see slip, p. 16).

³¹ With this last point the court below apparently was in agreement. After making certain quotations from the Stone patent which might be argued to describe the Marconi invention, the court said (in its 1935 Special Finding LIV, 81 C. Cls. 716):

"The quotations from lines 16-20 of page 2 and lines 62-66 of page 6 of the Stone specification were inserted by the amendment of April 8, 1902, after the application was filed in the Patent Office."

The Marconi application was filed November 10, 1900.

and this holding was based on the same prior patents and publications that had been considered in the prior decisions. The holding was therefore not based on new evidence and was in direct conflict, not only as to result but also as to reasoning, with the prior decisions. Further discussion, on the merits, of the validity of the Marconi patent therefore does not appear necessary at this stage of the case.

B. The above-mentioned claims of the Marconi patent were infringed.

As to the merits of the question of infringement, it seems necessary only to quote from the opinion of the Court of Claims:

"We think it clear that the plain open-gap apparatus would be an infringement if the patent was valid, and we are likewise of the opinion that this would be true as to the apparatus using the rotary gap
• • • (81 C. Cls. 768.)

As to quenched-gap apparatus, the opinion stated:

"It also appears that when it was used it was necessary to follow the same method of tuning as before."
(81 C. Cls. 769.)

It seems clear that the court below considered that, if the patent were valid, it was infringed.

Petitioner therefore submits that, with respect to Marconi patent No. 763,772, the merits of the case are such that, in view of the direct conflict of decision as to the validity of the patent, this Court should review the decision of the court below denying to petitioner compensation based on that patent.

POINT V.

The Fleming patent No. 893,684 was valid as to claims 1 and 37 thereof and the subject matter of said claims was used by respondent.

A. The patent was infringed.

The Fleming patent constituted the first disclosure of a multiple-element vacuum tube for use at the high electrical frequencies employed in radio—frequencies normally above 15,000 cycles per second and running up into millions of cycles. The specific disclosure of the patent was the use of a two-element vacuum tube ("Fleming valve") as the rectifying element of a radio detector.

Rather than attempt to set forth here the technical details of the operation of vacuum tubes we refer this Court to its own decisions in *Radio Corporation of America v. Radio Engineering Laboratories*, 293 U. S. 1, 10-11 and in *DeForest Radio Co. v. General Electric Co.*, 283 U. S. 663, 670 *et seq.*, and, with particular reference to the Fleming patent, to the decisions of the District Court and the Circuit Court of Appeals in the *DeForest* suit on that patent (239 Fed. 942 and 243 Fed. 560).

The controlling fact on the question of infringement is that Fleming taught the art that the action of a vacuum tube containing an incandescent electrode (filament or cathode) and another, cold, electrode (plate or anode) was substantially without inertia, that such a tube would operate at or respond to the extremely high frequencies used in radio, and, specifically, that suitable electrical circuits and apparatus, utilizing such a vacuum tube, operated to detect the presence of radio signals.

Dr. Lee DeForest, who had been carrying on abortive experiments with various gaseous devices for use in radio, learned of Fleming's invention and, shortly afterwards,

added a third element inside of the vacuum tube which, in a later form, was located between the filament and the plate of the Fleming valve and became known as the "grid" or "control electrode".

This was an invention of great importance, as has been universally recognized, but it was a direct outgrowth of and was built on the Fleming invention. As this Court expressed it in *Radio Corporation v. Radio Engineering Laboratories*, 293 U. S. 1, at p. 11:

"DeForest's 'audion' changed the Fleming tube by interposing a special wire known as the 'grid' between the filament and the plate, thereby increasing its capacity as a detector of waves of radio or inaudible frequency and serving better to transform them into waves of audible frequency."

That the DeForest tube was a direct out-growth of and built on the Fleming invention was specifically held by both courts in the *DeForest* case (236 Fed. at page 955 and 243 Fed. at page 569). The Circuit Court of Appeals said:

"He [DeForest] began with the heated gas theory; he ended with the three-electrode audion, employing the commercial vacuum, and before he produced that success he learned of Fleming's invention and the latter's address before the Royal Society."

The Court of Claims, in the present case, disregarded this fact and, we submit, considered the question of infringement on narrow, technical grounds.

For the purposes of the present petition, we submit that, without further argument, it is clear that a decision of non-infringement under the circumstances stated above and under Point II, especially in view of the prior contrary decision of the Circuit Court of Appeals for the Second Circuit, is one which calls for review by this Court.

It seems unnecessary to consider here the further findings

of the court below (also contrary to the decisions of the Southern New York District Court) that the Fleming patent was not infringed by respondent's use of amplifiers and generators of oscillations utilizing three-element tubes or audions, since the direct conflict with the decision of the Circuit Court of Appeals on the question of infringement by detectors should, in our opinion, be sufficient to induce this Court to review the case.

B. The Fleming patent was valid.

On the question of validity, the Court of Claims, in its opinion, stated that it considered the patent invalid because of unreasonable neglect and delay in filing the disclaimer, citing the decision of this Court in *Easton v. Simon, Ascher & Co.*, 282 U. S. 445, 452. This question, as we have shown above, was specifically before the New York courts in the *De Forest* case, but was overruled by both courts.

The disclaimer limited the subject matter of the patent to use of the Fleming valve with high or radio frequencies; it therefore did no more than limit the patent to the invention which was described therein specifically and in considerable detail. It in no wise affected claim 37 of the patent (one of the claims here in suit).

Even if the patent, as originally issued, may be said, in claim 1 or elsewhere, to have attempted to cover the use of the Fleming valve as a rectifier of low frequencies, it did not seek to cover "more than that of which he [the patentee] was the original or first inventor or discoverer" (the situation to which the disclaimer provisions of the statute apply). For, so far as appears from the record herein, Fleming was the original and first inventor or discoverer of the fact that the two-element vacuum tube would rectify low-frequency, alternating currents (respondent's witness Miller, "Other parts" R., p. 679).

Under such circumstances, the disclaimer provisions of the patent statutes and the decision of this Court in the *Ensten* case have no application.³² These provisions, embodied in Revised Statutes sections 4917 and 4922 (U. S. Code, Title 35, sections 65 and 71), are set forth in Appendix C (*infra*, pp. 38-39). By their terms they are applicable only when the patentee "has claimed *more* than that of which *he* was the original or first inventor or discoverer" or when he has "claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which *he* was *not* the original and first inventor and discoverer".

Respondent has not shown that Fleming was not the first inventor or discoverer of low-frequency rectification—the disclaimed matter. Therefore, even if Fleming disclosed such low-frequency rectification a considerable time before he filed his application for the patent in suit, and even if the patent, as issued, purported to cover such use of the Fleming valve, nevertheless the patent did not claim more than that of which Fleming was the original and first inventor or discoverer. The disclaimer provisions of the statute, therefore, by their specific terms, do not apply to the Fleming patent.

We of course do not assert that, if Fleming published a description of the use of his tube as a rectifier of low-frequency currents more than two years before his application was filed, he had the right validly to claim such use in the patent. What we do assert is that the Court of Claims was clearly in error in attempting to apply the disclaimer provisions and in asserting that the patent was void for unreasonable neglect and delay in filing a disclaimer.

³² In the case of the *Ensten* patent, the invalid claim was too broad and included "More than that of which he, the patentee, was the original or first inventor or discoverer." *Ensten v. Rich-Sampler Co.*, 13 Fed. (2d) 132, 133.

Even if the disclaimer sections of the statute were applicable to the circumstances above set forth, and even if, in so far as the patentee himself was concerned, it might be thought that there was unreasonable neglect and delay, we nevertheless submit that those sections do not invalidate the patent in so far as *petitioner* is concerned.

We note, first, that Revised Statutes section 4917 states that the patent "*shall be valid* for all that part which is truly and justly" the patentee's, and that the "patentee, his heirs *or assigns*, whether of the whole or any sectional interest therein, *may* * * * make disclaimer", etc. The statute also provides that the disclaimer is applicable only to the interest possessed by the one filing it (and those claiming under him).

In Revised Statutes section 4922, we find the provision that a suit at law or in equity may be maintained by the "patentee, his executors, administrators, and *assigns*" for infringement of any part of the patent "which was *bona fide* his own, * * * notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer." The section then provides, as penalty for failure to file a disclaimer before commencement of suit, that "plaintiff" (i. e., the patentee, his executors, administrators, or assigns) shall not recover costs. The last sentence of the section reads:

"But *no patentee* shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer."

This is the only portion of the statute which requires that the disclaimer be filed promptly. In the absence of this sentence, failure to file a disclaimer would only affect the recovery of costs and, by the very terms of the statute, the patent would be valid as to all parts thereof of which the patentee was the first inventor or discoverer.

Throughout these two sections, Congress carefully distinguished between the patentee and those claiming under him (such as his assignees). The provision as to unreasonable neglect and delay applies, by its terms, only to the patentee and not to his assigns. Thus Congress saw fit to deprive a dilatory patentee (who had made oath to certain facts) of the benefits of this remedial statute but did not see fit to deprive his assignee of such benefits.³³ If it had been the intention of Congress, to make no distinction here between the patentee and his assignee, there would have been no difficulty in making this sentence read that no one maintaining such a suit at law or in equity should be entitled to the benefits of the section if there had been unreasonable neglect and delay in entering a disclaimer. Such, however, is not the way that the statute reads.

Petitioner therefore submits, as to the disclaimer, first, that Revised Statutes sections 4917 and 4922 do not apply where, as here, the patentee was himself the first inventor or discoverer of the disclaimed subject matter; and second, that the unreasonable neglect and delay provision of Revised Statutes section 4922 does not apply to the assignee of a patent.

We also submit that a proper construction of the patent, as originally issued and without the disclaimer, would construe claim 1, if necessary to sustain the validity thereof, as limited to the use of the apparatus thereof in connection with high-frequency currents, as described in the specification; that therefore, the disclaimer was unnecessary; and that the disclaimer, in any event, did no more than clarify the scope of the patent and should not be held to have invalidated it, or to have deprived petitioner of the right to recover from respondent for its unauthorized use of the subject matter thereof.

³³ Note that the far less drastic provision (that relating to costs) does, by the terms of the statute, apply both to patentee and assignee.

The Court of Claims, in its opinion, did not specifically pass on the other grounds of invalidity urged by respondent. The opinion, to us, indicates that the court below considered that, except for the disclaimer, the patent was valid. In view of the careful consideration of these other questions by the two New York courts, the lower of which had seen and heard the witnesses, we do not think that further discussion of the question of validity is necessary at this stage of the present case.

Petitioner therefore submits that, with respect to the Fleming patent, the merits of the case are such that, in view of the direct conflict between the decisions of the Court of Claims and of the Circuit Court of Appeals for the Second Circuit, this Court should review the decision of the Court below denying to petitioner compensation based on the Fleming patent.

Conclusion.

WHEREFORE, Petitioner respectfully prays that the petition for writ of certiorari be granted, the cause reviewed, and the judgment of the Court of Claims reversed in so far as error therein has been assigned by Petitioner.

Respectfully submitted,

ABEL E. BLACKMAR, JR.,

RICHARD A. FORD,

Counsel for Petitioner.

APPENDIX A.

Act of June 25, 1910, as amended July 1, 1918 (U. S. Code, Title 35, section 68): Whenever an invention described in and covered by a patent of the United States shall hereafter be used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, such owner's remedy shall be by suit against the United States in the Court of Claims for the recovery of his reasonable and entire compensation for such use and manufacture: *Provided, however*, That said Court of Claims shall not entertain a suit or award compensation under the provisions of this act where the claim for compensation is based on the use or manufacture by or for the United States of any article heretofore owned, leased, used by, or in the possession of the United States: *Provided further*, That in any such suit the United States may avail itself of any and all defenses, general or special, that might be pleaded by a defendant in an action for infringement, as set forth in title sixty of the Revised Statutes, or otherwise; *And provided further*, That the benefits of this act shall not inure to any patentee who, when he makes such claim, is in the employment or service of the Government of the United States, or the assignee of any such patentee; nor shall this act apply to any device discovered or invented by such employee during the time of his employment or service.

APPENDIX B.

Resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That the Secretary of the Interior be, and he is hereby, authorized and directed to grant permission to The Marconi Memorial Foundation, Inc., for the erection on public grounds of the United States in the District of Columbia, other than those of the Capitol, the Library of Congress, and the White House, of a memorial of simple and artistic form to the late Guglielmo Marconi, inventor of an apparatus for wireless telegraphy, by the American people: *Provided*, That the site chosen and the design of the

memorial shall have the approval of the National Commission of Fine Arts and that the United States shall be put to no expense in or by the erection of the said memorial: *Provided further*, That unless funds, which in the estimation of the Secretary of the Interior are sufficient to insure the completion of the memorial, are certified available, and the erection of this memorial begun within five years from and after the passage of this legislation, the authorization hereby granted is revoked.

APPENDIX C.

Revised Statutes section 4917 (U. S. Code, Title 35, section 65): Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

Revised Statutes section 4922 (U. S. Code, Title 35, section 71): Whenever, through inadvertence, accident, or mistake, and without any willful default, or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, adminis-

trators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

Here follows 2 Exhibits 21 and 22